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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,215	06/21/2001	Chad A. Stevens	10010428-1	8409

7590 10/21/2004
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

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ART UNIT	PAPER NUMBER
2853	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/888,215
Filing Date: June 21, 2001
Appellant(s): STEVENS, CHAD A.

Steven L. Nichols
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 26 July 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-4, 9, 10, 12-19 and 25 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

2,293,887	Chamberlain	8-1942
3,589,507	Greenberg	6-1971
4,882,621	Suzuki et al.	11-1989
4,992,121	Rubino	2-1991
5,334,431	Longtin	8-1994
5,579,446	Naik et al.	11-1996
6,284,339 B1	Floegel et al.	9-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. With regards to claims 12-14, Floegel et al. disclose an electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium (element 12);

an electrostatic charge deposited on a side of said sticker print medium (column 3, lines 11-15);

a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium (element 14, column 4, lines 29-31);

wherein said sticker print medium is made of vinyl (column 4, lines 61-62); and

wherein said sticker print medium is transparent (column 1, lines 29-35).

3. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Longtin (U.S. 5,334,431).

Longtin discloses an electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium (column 1, lines 29-31, 58-61 and column 2, lines 4-9, fig. 1 shows the blank labels and the stickers shown in fig. 2 were necessarily blank prior to printing);

an electrostatic charge deposited on a side of said sticker print medium (column 3, lines 6-9); and

a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium (fig. 1, element 20, column 1, lines 22-31);

wherein said sticker print medium is made of transparent vinyl (column 3, lines 8-10 and 15-16);

wherein the sheet is perforated to define a plurality of sticker panes (fig. 1, element 46, column 4, lines 4-6).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain.

Floegel et al. disclose a method of making a user-customized electrostatic sticker, said method comprising:

printing a user-selected image on sticker print medium (column 1, lines 13-16 and column 2, lines 34-37), said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker (column 1, lines 56-58 and column 2, lines 30-32);

applying said sticker such that a side of said sticker bearing said electrostatic charge is in contact with a surface to which said sticker is applied (column 4, lines 39-40, both sides are charged, lines 22-26); and

perforating one or more sections of said sticker print medium (column 3, lines 25-28).

Floegel et al. do not disclose depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image, wherein said charge donor is separate from, and not a part of, said sticker print medium.

However, Chamberlain discloses depositing a charge to a permanently charged print medium during mounting of the medium to a surface, wherein said charge donor is separate from, and not a part of, said sticker print medium (column 1, line 55-column 2, line 7).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide an electrical charge on the medium with a separate charge donor as taught by Chamberlain.

The reason for doing such would have been to increase the strength of attraction or adhesion when mounting the medium (column 2, lines 1-2).

6. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain as applied to claims 1, 9 and 10 above and further in view of Suzuki et al. (U.S. 4,882,621).

Floegel et al. as modified by Chamberlain disclose everything claimed with the exception of reversing the image during printing.

Suzuki et al. disclose a printing device which uses a mode selecting switch (16) to enable a mirror image converting circuit (4) to perform a mirror image conversion on data from a host apparatus when transparencies are used as the recording medium (column 2, lines 43-47 and column 3, lines 36-50).

It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the reversing device of Suzuki et al. into the invention of Floegel et al. as modified. The reason for performing the incorporation would have been to enable image data to appear in the proper orientation when printing on a transparent media.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain and Suzuki et al. as applied to claims 2 and 4 above, and further in view of Naik et al. (U.S. 5,579,446).

Floegel et al. as modified do not disclose the host computer with a printer driver performing operations on the image.

However, Naik et al. disclose a host computer which performs image processing, then sends the processed image to the printer through a printer driver (fig. 1, column 5, lines 34-41).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Floegel et al. as modified to perform the processing using a printer driver of the host computer. The reason for performing the modification would have been to reduce the cost and complexity of and burden on the printing apparatus by performing computations using the host computer.

8. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chamberlain in view of Greenberg (U.S. 3,589,507).

Chamberlain discloses an electrostatic sticker kit comprising:

a kit including:

at least one blank sheet of an electrostatic sticker print medium (column 1, lines 18-35, sticker in fig. 3a is blank); and

a charge donor other than said sticker print medium for depositing an electrostatic charge on either side of said sticker print medium (column 1, line 55-column 2, line 7);

wherein said at least one blank sheet of sticker print medium and said charge donor are associated together in said kit (the sticker and the charge donor are considered part of a kit which allows a sticker to be reliably attached to a structure, the term kit merely requires the elements to be associated together in some manner);

wherein said sticker print medium is made of vinyl (column 1, lines 21-22, Koroseal is one of the most popular forms of vinyl);

wherein said sticker print medium is transparent (column 3, lines 19-24); and wherein said sheet of print medium is perforated to define a plurality of sticker panes (column 2, lines 45-52).

Chamberlain does not expressly disclose the sticker packaged in a kit.

Greenberg disclose packaging a display system, including all required materials, in a kit (fig. 1).

It would have been obvious to one having ordinary skill in the art at the time of the invention to package the media and charge donor of Chamberlain in a kit, as suggested by Greenberg. The reason for performing the modification would have been to facilitate sale and provide convenience to an end user.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubino in view of Greenberg.

Rubino discloses a method comprising providing an electrostatic sticker kit, said providing an electrostatic sticker kit comprising providing a kit containing at least one blank sheet of an electrostatic sticker medium and a charge donor, other than said sticker medium, for depositing an electrostatic charge on either side of said sticker medium (abstract), wherein said at least one blank sheet of an electrostatic sticker print medium and said charge donor are associated together to form said kit. Further the sticker medium is capable of use in a printing device.

Rubino does not expressly disclose the sticker packaged in a kit.

Greenberg disclose packaging a display system, including all required materials, in a kit (fig. 1).

It would have been obvious to one having ordinary skill in the art at the time of the invention to package the media and charge donor of Rubino in a kit, as suggested by Greenberg. The reason for performing the modification would have been to facilitate sale and provide convenience to an end user.

(11) Response to Argument

1. The 112 1st. paragraph rejection is withdrawn. It would have been obvious to one of ordinary skill in the art to package the claimed invention, or any invention, in a kit.
2. With regards to the rejection of claims 12-14 as being anticipated under 102(b) by Floegel et al., Appellant argues that Floegel et al. do not teach or suggest a charge deposited on a side of the sticker medium and a protective backing over the charge on the blank sheet of print medium.

In response to the first argument, that Floegel et al. do not teach a charge deposited on a side of the sticker medium, the manner in which the charge is provided on the sheet, whether it be an inherent property of the sheet, or deposited on the sheet, does not effect the structure of the sheet. Since the claim is an apparatus claim, only limitations which further limit the structure of the sheet can further limit the claim. The limitation "deposited on a side of the sticker medium" is a limitation directed towards the method of manufacturing the sheet, not the structure of the sheet. The limitation merely

requires that the sheet have a charge and Floegel et al. clearly teach this on column 1, lines 43-61. Further, even if one were to give patentable weight to this limitation, Floegel et al. explicitly state that the charge is "generated by passing the plastic sheet through an electric field while the sheet is held at an elevated temperature". Appellant states that in Floegel et al. the charge is not deposited on the sheet but rather is the result of polarization. Appellant's claim uses the language "a charge deposited on a side of a sheet". Polarizing the sheet moves like charges towards the edge or side of the sheet and thus constitutes depositing a charge on a side of a sheet.

In response to Appellant's second argument, that Floegel et al. do not teach a protective backing, element 14 is a "backing sheet" protecting the back of the media.

3. With regards to the rejection of claims 12-15 as being anticipated under 102(b) by Longtin, Appellant argues that Longtin does not disclose a charge deposited on a side of the sticker print medium and a print medium that is simultaneously blank, covered on one side by a deposited charge and joined with a protective backing over that charge.

In response to the first argument, as discussed above, the manner in which the charge appears on the sheet does not limit the structure of the sheet as claimed in the apparatus claims.

In response to the second argument, the sheet is simultaneously blank, covered on one side by a charge and joined with a backing, as shown in fig. 1.

Fig. 2 shows the labels with writing provided thereon, however at column 1, lines 29-31, Longtin states that "for ease of manufacture, shipping, storage and handling static cling labels have in the past been applied to releasable liners", or backings, and at column 1, lines 58-61, Longtin states that "once the static cling label is removed from the liner, the label is susceptible to folding, adhering to the person carrying tile label and to clinging to surfaces to which the label contacts". Prior to printing, the sheet shown in fig. 2 was blank. Longtin states that the backing is necessary to protect the sheet during manufacturing, which would include providing the markings on the blank sheet. Without the backing, as stated by Longtin, the sheet would be susceptible to folding and clinging to surfaces which come into contact with the label and the manufacturing process of the sheet would be compromised.

Thus, fig. 1 shows the blank charged sheet with a protective banking, and given the evidence and statements provided by Longtin, it is clear that reliability of manufacture is adversely affected if information is printed on the sheets without the label provided for protection.

4. With regards to the rejection of claims 1, 9 and 10 as being unpatentable under 103(a) over Floegel et al. and Chamberlain, Appellant asserts that Chamberlain discloses a different type of sheet which is not permanently charged and argues that since the sheet of Floegel et al. is permanently charged, the strength of adhesion cannot be increased by rubbing the sheet with a charge donor. Appellant further states that the sheet would repel any like charges and prevent further charge from building up on the sheet.

Floegel et al. disclose a vinyl sheet which has an inherent/permanent electrostatic charge (column 4, lines 61-62). Similarly and contrary to Appellant's assertion that "Chamberlain was not working with a permanently charged electret which would behave differently", Chamberlain uses a material known commercially as Koroseal, which is one of the most popular forms of vinyl and which inherently/permanently carries an electric charge (column 1, lines 24-28). Thus, clearly Floegel et al. and Chamberlain disclose the same type of sheet, vinyl and both carry a permanent charge.

Appellant has provided no evidence, other than unsupported statements, that the charge on the sheet would not be increased by a charge donor, while Chamberlain states that rubbing the permanently charged vinyl sheet with a charge donor increases the strength of attraction and the electrical effect (column 1, line 55- column 2, line 7). The examiner does not disagree with Appellant's statement that like charges repel, rather, as one of ordinary skill in the art would recognize, the interaction amongst a large number of charged particles on a sheet is far more complicated than a rudimentary application of Coulomb's Law. The teachings of the prior art would suggests to one of ordinary skill in the art that the charge can be increased and Appellant has provided no scientific evidence that would potentially compel one of ordinary skill in the art to doubt the findings of Chamberlain.

5. With regards to the rejection of claims 16-19 as being unpatentable under 103(a) over Chamberlain in view of Greenberg et al., Appellant argues that Chamberlain does not disclose a blank sheet of medium and neither reference teaches the claimed materials packaged in a kit.

In response to the first argument regarding the blank sheet, fig. 3a of Chamberlain clearly shows a blank sheet. The sheet consists of blank materials which are perforated to define various shapes which may be arranged to produce designs.

In response to the second argument regarding the packaged kit, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Chamberlain teaches a charge donor and a sheet of electrostatic media, while Greenberg et al. teach packaging in a kit all of the materials required to hang a display on a wall, including adhesive pads, an instruction booklet and plates (column 2, lines 31-65). Since Chamberlain discloses the media and charge donor for a wall display and Greenberg et al. disclose packaging in a kit all materials required to provide a display on a wall, the combination teaches the claimed invention. Additionally, it is the Examiner's opinion that solely considering the primary reference's teaching of all of the essential elements, it would have been obvious to one having ordinary skill in the art at the time of the invention to package these elements in a kit to provide ease of sale and convenience to a user.

6. With regards to the rejection of claim 25 as being unpatentable under 103(a) over Rubino in view of Greenberg, Appellant argues that Rubino does not disclose a blank sheet, a sticker print medium and that the combination does not teach packaging a print medium and charge donor in a kit.

Rubino discloses that the sheet is for supporting other materials, such as normal uncharged paper. There is no need to form any markings on the sheet, Rubino does not mention markings on the sheet, and the sheet is blank. Further, the sheet is capable of being used in a printer and therefore may be a sticker print medium.

In response to the argument regarding the packaged kit, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Rubino teaches a specific, superior charge donor and a sheet of electrostatic media, while Greenberg et al. teach packaging in a kit all of the materials required to hang a display on a wall, including adhesive pads, an instruction booklet and plates (column 2, lines 31-65). Since Rubino discloses the media and charge donor for a wall display and Greenberg et al. disclose packaging in a kit all materials required to provide a display on a wall, the combination teaches the claimed invention. Additionally, it is the Examiner's opinion that solely considering the primary reference's teaching of all of the essential elements, it would have been obvious to one having ordinary skill in the art at the time of the invention to package these elements in a kit to provide ease of sale and convenience to a user.

Further, it is noted that the claimed invention would also be unpatentable over Chamberlain in view of Greenberg.

For the above reasons, it is believed that the rejections should be sustained.



Respectfully submitted,



Julian D. Huffman
October 15, 2004



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